

Notice of Allowability

Application No.

10/030,066

Examiner

Daniel S. Metzmaier

Applicant(s)

BOHNEN ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to filings of Aug. 16 & 20, 2004 & the interview of Sept. 2, 2004.
2. ☒ The allowed claim(s) is/are 18-24 and 27-40.
3. ☒ The drawings filed on 03 January 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 9/2/2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

Claims 18-24 and 27-40 are allowed.

Terminal Disclaimer

1. The terminal disclaimer filed on August 16, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent 6,224,846 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner's amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

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In the specification:

Replace the paragraph beginning at page 2, line 29, to page 3, line 6, as follows:

In US 3,018,172, a process is described for the preparation of aluminum hydroxides that are dispersible in non-polar, high-molecular organic solvents, such as mineral oils. In said process, aluminum alkoxides in a volatile organic solvent are hydrolyzed by contact with an organic sulfonic acid, such as postdodecylbenzenesulfonic acid in a viscous organic carrier fluid. After hydrolysis, the volatile organic solvent is removed and an aluminum hydroxide dispersed in a viscous organic carrier fluid, such as xylene, remains.

Replace the paragraph beginning at page 5, line 31, to page 6, line 4, as follows:

Suitable protic polar organic, optionally high-molecular, solvents (II) having at least two carbon atoms include alcohols, polyethers (with at least one free hydroxy group), hydroxyalkyl esters, and hydroxyalkyl ketones, or carboxylic acids. Suitable alcohols include for example ethyleneglycol, C₂ to C₈ mono- or dihydroxy alcohols, such as propanols, butanols, pentanols and hexanols.

Replace the paragraph beginning at page 6, line 35, to page 7, line 6, as follows:

Part of the suspensions obtained in this way are translucent. They produce transparent coatings, for example on films/foils, glass, or similar surfaces. As a result of their dispersibility in organic solvents, the aluminas modified in this way are suitable for incorporation into various water-insoluble polymers or lacquers/paints.

Reasons for allowance

3. The following is an examiner's statement of reasons for allowance: the amendment merely clarifies the poor copy scanned into the record. No substantive change has been made.

Applicants' response has obviated the rejections over the prior art of record. The limitation to non-aqueous organic solvent finds basis in the examples. Attention is directed to MPEP 2173.05(i), *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977), and at least the examples, particularly example 2 of the instant specification; which shows both aqueous and non-aqueous organic solvent systems.

The rejection under 35 USC 112, first paragraph, has been withdrawn upon further consideration based on applicants response and the interview of September 2, 2004, wherein it was noted that original claim 9 was an original claim in the PCT application. The subject matter of claims 37 and 39 find support as set forth in the response. The subject matter of claim 38 finds support in original claim 9. See MPEP 2163 and *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

The claimed terms "metal aquoxides" has been interpreted as "hydrated metal oxides". See pages 1-3 and abstract of the originally filed specification for discussion of prior art and reference to alumina hydrates and/or hydrated metal oxides.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM